

UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office  
Trademark Trial and Appeal Board  
2900 Crystal Drive  
Arlington, Virginia 22202-3513

Cissel

THIS DISPOSITION IS NOT  
CITABLE AS PRECEDENT OF  
THE TTAB 4/18/00

Opposition No. 103,859

Trek Bicycle Corp.

v.

Alyx Fier

Before Sams, Cissel and Bottorff, Administrative Trademark  
Judges.

Opinion by Cissel, Administrative Trademark Judge:

On February 6, 1996, Alyx Fier, an individual, applied  
to register the mark "TREKNOLOGY" on the Principal Register  
for "travel and all purpose athletic bags," in Class 18.  
Applicant claimed first use of the mark on these products in  
September of 1991, and first use in interstate commerce in  
August of 1993.

A timely notice of opposition was filed by opposer on  
October 29, 1996. As grounds for opposition, opposer  
asserted ownership of a registration<sup>1</sup> for the mark "TREK"  
and prior use of it as a trademark for bicycles, bicycle  
frames and related products since 1976; that in addition to

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<sup>1</sup> Reg. No. 1, 168,276, issued on the Principal Register on Sept.  
8, 1981. Affidavit under Sections 8 and 15 filed and accepted.

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bicycles, opposer also uses its "TREK" mark on travel bags and all-purpose athletic bags; that such bags have been sold bearing the "TREK" mark since at least as early as 1988; that many of opposer's "TREK" bags are designed for general use and are not limited to use in connection with bicycles; that opposer is recognized as a leader in bicycle technology and innovation; that, as a result of extensive use and promotion, the mark "TREK" has become a famous trademark; that, prior to applicant's use of the mark he seeks to register, opposer had used and promoted "TREKNOLOGY" as a "trade identity designation in its catalogues and sales literature" in connection with opposer's bicycles and related products; that opposer's ownership of registrations for the marks in "TREKKING" and "TREK 100" establish that opposer owns a family of "TREK" marks; and that applicant's mark, as applied to the goods set forth in the application, so resembles opposer's "TREK" mark and opposer's "TREKNOLOGY" designation that confusion is likely.

Applicant's answer essentially denied these allegations.

This case now comes before the Board for consideration of opposer's motion for summary judgment, filed on August 17, 1998, and applicant's cross-motion for summary judgment,

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filed, along with applicant's response to opposer's motion,<sup>2</sup> on October 7, 1998. Opposer's response to applicant's cross-motion for summary judgment has, of course, also been considered.

In support of its motion for summary judgment, opposer has submitted extensive evidence, namely two volumes of documents, including the depositions of three witnesses and a copy of the unpublished opinion of this Board in Opposition No. 94,948. In that case, we held confusion to be likely between the mark of applicant shown below,

as applied to the same goods specified in the instant application, and opposer's registered "TREK" mark in connection with opposer's bicycle products and travel bags and all-purpose athletic bags.

Opposer's position is that the materials submitted in connection with its motion and applicant's cross-motion establish that there are no genuine issues of material fact

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<sup>2</sup> Notwithstanding previous admonishment by the Board for filing papers late in this proceeding, applicant nonetheless requested the Board to consider its late-filed response and cross-motion. Opposer has objected. In view of the policy of the Board to resolve cases on their merits wherever it is possible and applicant's assertion that the delay was unavoidable, as well as the fact that the impact of the delay was minimal, we have once again exercised our discretion by considering applicant's untimely submission.

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in dispute in the instant case, and that, based on the undisputed facts, opposer is entitled to summary judgment in its favor as a matter of law. Opposer also argues that in view of the Board's decision in the earlier opposition proceeding, the principle of collateral estoppel requires the Board to render judgment in the case at hand in favor of opposer at this juncture, prior to a trial.

In response to opposer's motion for summary judgment, applicant argues that the existence of "numerous" genuine issues of fact makes summary judgment for opposer inappropriate. Applicant does not identify any such issues, however. Instead, in apparent recognition of the fact that there are no disputes with respect to any material facts in this case, applicant contends that based on the undisputed facts, applicant, rather than opposer, is entitled to summary judgment. Accordingly, applicant moves for summary judgment in his favor, and asks the Board to dismiss the opposition. Attached to its cross-motion and opposition to opposer's motion were a number of exhibits, most of which had been submitted in connection with Opposition No. 94,948.

As has often been stated, summary judgment is an appropriate method of disposing of cases in which there are no genuine issues of material fact in dispute, thus leaving the case to be resolved as a matter of law. See Fed. R. Civ. P. 56(c). A party moving for summary judgment has the

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initial burden of demonstrating the absence of any genuine issue of material fact. See *Celotex Corp. v. Catrett*, 477 U.S. 317 (1986); *Sweats Fashions Inc. v. Pannill Knitting Co. Inc.*, 833 F.2d 1560, 4 USPQ2d 1793 (Fed. Cir. 1987). A factual dispute is genuine if, on the evidence of record, a reasonable fact finder could resolve the matter in favor of the nonmoving party. See *Opryland USA Inc. v. Great American Music Show Inc.*, 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992). The evidence must be viewed in the light most favorable to the nonmovant, and all justifiable inferences are to be drawn in favor of the nonmovant. *Lloyd's Food Products Inc. v. Eli's Inc.*, 987 F.2d 766, 25 USPQ2d 2027 (Fed. Cir. 1993); *Opryland USA*, supra.

When we apply these principles to the situation in the instant case, we find that we are in agreement with both applicant and opposer that there remain no genuine issues of material fact, and that a trial is therefore unnecessary. Although we do not agree with opposer that opposer is entitled to judgment in this case because our decision in Opposition No. 94,948 has already resolved the issues before us in the instant proceeding, it is clear that based on the undisputed facts established by the materials of record in connection with these cross-motions for summary judgment, opposer has priority and confusion is likely between

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applicant's mark and opposer's previously used and registered mark "TREK."

Just as in the earlier opposition, we find it unnecessary to determine whether opposer's very limited use of the designation "TREKNOLOGY" in connection with its bicycles constitutes sufficient use as a trademark to bar registration of applicant's mark. Opposer's prior use of "TREK" in connection with both bicycles and travel and all-purpose bags establishes the basis for refusing to register applicant's mark under Section 2(d) of the Act.

Contrary to opposer's contentions, our decision is not based on a finding that opposer has established a family of marks which have "TREK" in common with each other. Although the materials of record in connection with opposer's motion show that opposer has adopted and used several marks incorporating this term, we have no evidence that opposer has promoted these marks together, or has referred to them as members of a family of "TREK" marks owned by opposer. Without such a showing, we cannot conclude that opposer is entitled to claim that it has a family of such marks. *Porta-Tool, Inc. v. DND Corp.*, 196 USPQ 643 (TTAB 1977).

As noted above, collateral estoppel is not the basis for our decision either. As even opposer acknowledges (brief, p.4), the first requirement to be met in order for collateral estoppel to apply is that the issue decided in

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the prior action must be identical to the one now under consideration. Plainly, the issue in Opposition No. 94,948 was whether confusion was likely in view of a mark which was different from the one with which we are concerned in the case now before us. The mark in the case at hand is a typed presentation of the term "TREKNOLOGY," whereas the mark in the prior proceeding included a significant design element, which the Board commented had the effect of separating and highlighting the "TREK" portion of that trademark. Because of the difference between that mark and the block letter presentation of the term "TREKNOLOGY" which is now sought to be registered, our decision in the prior case finding confusion to be likely with respect to that mark is not determinative of the outcome in the instant proceeding.

We are not persuaded to the contrary by opposer's argument that whatever similarity is reduced by the unification of "TREK" and "NOLOGY" in the instant case is more than compensated for by the removal of the otherwise distinguishing design element in applicant's previously opposed mark. The simple fact is that distinctions can be readily drawn between each of applicant's two marks, and these distinctions have relevance to the question of why confusion with opposer's mark "TREK" would or would not be likely. Because the issue in this proceeding is not

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identical to the one we decided in the prior case, collateral estoppel does not apply.

Even though our decision in Opposition No. 94,948 is therefore not controlling in this one, opposer has submitted sufficient evidence to establish that there are no genuine issues of fact which would require a trial to resolve. The materials of record, including the testimony Mr. Sullivan, Mr. Norquist, and Mr. Gordon, as well as the exhibits thereto and a host of other documents made of record in connection with the motions, clearly demonstrate that opposer's mark "TREK" is famous for bicycles and accessories, and that opposer has used this mark in connection with goods which are encompassed within the identification-of-goods clause in the opposed application since 1988, which is long before applicant adopted its mark.

The fame of opposer's "TREK" mark carries great weight in our resolution of whether confusion is likely in this case. As our reviewing court has made clear, famous marks are afforded more protection against confusion. *Kenner Parker Toys v. Rose Art*, 963 F.2d 350, 22 USPQ2d 1453 (Fed. Cir. 1992). Particularly in view of the fame of opposer's mark, applicant's mark so resembles opposer's mark that when both marks are used on the same kinds of products, confusion is likely.

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Applicant's "TREKNOLOGY" mark embodies opposer's famous "TREK" mark in its entirety, and adds to it the clear reference to technology. Just as in the earlier proceeding between these parties, the materials of record in connection with the motions establish that opposer's advertising and promotion seek to emphasize that "TREK" bicycles embody the highest technology available in this field. Opposer's very limited use of the term "TREKNOLOGY" in connection with its top-of-the-line bicycles exemplifies this, and the record is replete with other examples of opposer touting its technological orientation. This fact and the obvious play on words created by combining "TREK" and "NOLOGY" facilitates the association between "TREKNOLOGY" and "TREK" in the minds of consumers.

People who are familiar with opposer's famous "TREK" bicycles and who are aware that "TREK" travel and all-purpose bags are also sold under this famous trademark are likely to assume, when essentially identical bags are sold under the mark "TREKNOLOGY," that they emanate from the same source which is responsible for products sold under the famous "TREK" mark. It is well settled that when marks are used on virtually identical goods, the degree of similarity necessary to support a conclusion that confusion is likely declines. *Century 21 Real Estate v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698 (Fed. Cir. 1992).

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Applicant's arguments and the documents attached to applicant's brief in opposition to opposer's motion for summary judgment and in support of applicant's cross-motion for summary judgment do not reveal the existence of any genuine issues of material fact, nor do they dictate judgment for applicant as a matter of law. Applicant's main point appears to be that because he is aware of no incidents of actual confusion, the issue of whether confusion is likely should be resolved in the negative. As this Board has frequently stated, however, the issue is not whether confusion has actually occurred, and evidence of actual confusion is notoriously hard to obtain. *Helene Curtis Industries Inc. v. Suave Shoe Corp.*, 13 USPQ2d 1618 (TTAB 1989). Rather, the issue is whether confusion is likely, and in situations like the one before us, where we have no evidence which would lead us to conclude that the opportunity for confusion has existed to any significant extent, the assertion by one party that it is not aware of any incidents of actual confusion carries little weight.

Applicant's other arguments are equally unpersuasive. For example, applicant contends that the fact that the word "trek" has a dictionary definition and is linked with travel to the Himalayas somehow makes opposer's famous trademark a generic term in connection with bicycles and packs. Applicant also argues that third-party trademark

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registrations for marks which include the word "trek" establish that opposer's famous trademark has become diluted. We have no evidence that any of the referenced marks are in use, however, so we have no basis upon which to adopt the position asserted by applicant. To the contrary, in light of the substantial evidence submitted by opposer, as noted above, opposer has established that its mark is a famous, strong mark in its field.

In summary, the Board agrees with both applicant and opposer that no genuine issues of material fact are in dispute, and that judgment can be rendered at this juncture without the necessity of a trial. The materials of record establish opposer's priority and that confusion is likely. Accordingly, summary judgment in favor of opposer is granted. The opposition is sustained and registration to applicant is refused.

J. D. Sams

R. F. Cissel

C. M. Bottorff  
Administrative Trademark Judges,  
Trademark Trial & Appeal Board

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